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Notice of Allowability

Application No.

10/828,727

Examiner

Susan W. Berman

Applicant(s)

CHISHOLM ET AL.

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Amendment filed 11/14/2005.
2. ☒ The allowed claim(s) is/are 1-24.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted:
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

EXAMINER'S COMMENT***Response to Amendments and Arguments***

The rejection of claims 1-15 and 18-23 under 35 U.S.C. 103(a) as being unpatentable over Fukushima et al (6,206,550) is withdrawn. Applicant has amended the claims to exclude compositions comprising bis(4-(meth)acryloylthiophenyl)sulfides, as taught by Fukushima et al.

Applicant points out differences between the brominated aromatic (meth)acrylate disclosed by Fong et al and the monomer set forth in instant claim 18 in the remarks filed 11/14/2005, pages 13-14. In response the rejection under 35 USC 102(b) is withdrawn.

The rejection of claim 12 under 35 U.S.C. 112, second paragraph, is withdrawn. Example 38 is referenced to show support for the recitation in claim 12 that the composition has a refractive index greater than or equal to 1.58. Table 7, in which example 38 is included, lists "RI Measured (liquid)" data. The refractive index "RI Measured (liquid)" is described in paragraph [0055] as the RI of the liquid curable compositions.

Terminal Disclaimer

The terminal disclaimer filed on 11/14/2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 6,833,391 has been reviewed and is accepted. The terminal disclaimer has been recorded.

REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance:

The closest prior art to the compositions set forth in instant claim 1 is considered to be Fukushima et al '550. The instantly claimed composition is distinguished from the compositions disclosed by Fukushima et al by excluding bis(4-(meth)acryloylthiophenyl)sulfides. The bis(4-(meth)acryloylthiophenyl)sulfides are the primary component in the compositions taught by Fukushima et

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al '550. However, applicant has found that the bis(4-(meth)acryloylthiophenyl)sulfides lower the cure speed and/or lower the degree of cure if present in the instantly claimed compositions when using a continuous process to prepare a cured film. See paragraph [0042]. The compositions are further distinguished from the cited prior art by comprising a substituted or unsubstituted arylthioether (meth)acrylate of the formula set forth in claim 1. Claim 24 recites a method of making the composition of claim 1 and thus requires the presence of the monomers set forth in claim 1.

Claims 13-15 are drawn to an optical film comprising the reaction product of the composition of claim 1. Claim 23 is drawn to an optical film comprising the reaction product of the composition of claim 18. These claims are considered to be allowable over the prior art since the polymerization product of the compositions would have a structure and properties determined by the monomer components and compositions comprising the monomer components set forth in the claims and also excluding bis(4-(meth)acryloylthiophenyl)sulfides are not taught in the prior art.

The claims 16 and 17 compositions are allowable because the "consisting essentially of" language limits the claimed composition to the two kinds of (meth)acrylate monomers set forth therein.

The compositions set forth in claims 18-22 comprise a brominated aromatic (meth)acrylate monomer wherein the phenyl group is substituted with 4 or 5 bromines. The closest prior art, to Fong et al (US 5,932,626 and US 5,908,874), discloses brominated aromatic (meth)acrylate monomers containing only three bromines in analogous compositions.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W. Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SB
1/9/06



Susan W Berman
Primary Examiner
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